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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,938	11/13/2003	Darshan Timbadia	128534-00701 (07027463)	9539
26565 7590 01/07/2009 MAYER BROWN LLP P.O. BOX 2828 CHICAGO, IL 60690				
EXAMINER				
MOSSER, KATHLEEN MICHELLE				
ART UNIT		PAPER NUMBER		
3715				
NOTIFICATION DATE		DELIVERY MODE		
01/07/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@mayerbrown.com

Office Action Summary

Application No.

10/712,938

Applicant(s)

TIMBADIA ET AL.

Examiner

Kathleen Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 13 and 20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 13, and 20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

In response to the amendment dated 10/24/2008 claims 2-12, 14-19 and 21-27 have been cancelled; claims 1, 13 and 20 remain pending.

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/425740, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The prior application fails to adequately disclose the limitations of "upon failure of the testing station, the initial state object and the changed state objects stored on the server are used to recreate the examination on the testing station at the point in the examination where the failure occurred" and that "the user will not be penalized for the time that questions are not available", as recited in claims 1, 13, and 20. There is no mention of either of these features in the prior filed document. As such, the claim for priority does not comply with the conditions for receiving priority, and the claims are given a date commensurate with the filing of the instant application (November 13th, 2003). The examiner notes that these features were added to the pending claims in the amendment dated 10/24/2008.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-13 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kershaw (US 5565316) in view of Ashley (US 2004/0229199). Kershaw teaches a system including: one or more testing stations (Figure 1, element 3), configured to receive a plurality of test items, display the test items to a user (administering the test), record state information comprising time elapsed from the start of the examination, identification of the test items displayed to the user, and user interactions with the testing stations, and transmitting the state information (the examinee performance file, the content and use of which is described starting at col. 39: 48); a first server computer system in communication with the one or more testing stations, wherein the first server computer system is configured to electronically transmit the test items to the one or more testing stations, receive user information and responses to the test items from the one or more testing stations and receive the state information from the one or more testing stations, and electronically store the state information at substantially the same time that the state information is received (Figure 3, element 2 and Figure 6); and a second server computer system in communication with the first server computer system, wherein the second server computer system is configured to receive user information and responses to the test items from the first server computer system and to deliver test packages to the first server computer system (figure 3 element 1 and Figure 4), as in claim 1.

With respect to claims 13 and 20, Kershaw further teaches the method of administering the examination including: synchronizing an initial state object on a server and one or more testing stations in communication with the server, wherein the initial state object comprises the time within which the examination must be completed and the test items to be presented to the user; delivering a plurality of test items to the one or more testing stations; displaying the plurality of testing items to the user and

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recording the user's responses and delivering to the server a changed state object comprising the time elapsed, the test items presented to the user, and the user's responses to the test items at substantially the same time that a triggering event occurs on the testing station, wherein the triggering event comprises the user providing a response to a test item, see the detailed description of the test delivery system starting in col. 30: 37 (note language taken from claim 13, but substantially similar features occur in claim 20 and can be found within the same citation). Further, upon the failure of the testing station, the initial state object and the changed state objects stored in the server are used to recreate the examination on the testing station at the point of the examination where the failure occurred (see figure 60), as in claims 1, 13 and 20.

Kershaw does not explicitly teach that the state information is transmitted at the same time that the state information is received (claims 1, 13, and 20) including when the user provides responses to the test items (claim 1) or that the user is not penalized for the time that questions are not available. Ashley teaches a computer based testing system with substantially similar computer architecture of Kershaw, which transmits student responses as they are entered by the student (paragraph 111). The system also includes several fault recovery scenarios (see the section starting at paragraph 122). It would have been obvious to one of ordinary skill in the art to include immediate transmission of the student's responses to the local repositories so as to ensure that the student's most recent testing information is available for immediate recovery should the student testing station fail. Ashley, like Kershaw fails to explicitly state that the student is not penalized for the time that questions are not available. The examiner takes OFFICIAL NOTICE that such a feature is well known in the art of standardized testing. Such a feature allows for compensations to the test taker should there be power failures, environmental failures (HVAC system, etc) or other significant interference with a test being administered. It would have been obvious to one of ordinary skill in the art to include such an assurance within the inventions of Kershaw and Ashley so as to ensure that the student is allowed to complete a test given the entirety of the time allotted for completion of the test.

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Response to Arguments

2. Applicant's arguments with respect to claims 1, 13 and 20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Mosser whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kathleen Mosser/
Primary Examiner, Art Unit 3715

January 4, 2009